

UNITED STATES PATENT AND TRADEMARK OFFICE

MAILED

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PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TAKAYUKI HASEBE,
RYOTA AKIYAMA and MAKOTO YOSHIOKA

Application No. 09/476,319

ORDER RETURNING TO EXAMINER

This application was received at the Board of Patent Appeals and Interferences on March 11, 2004. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith returned to the examiner. The matters requiring attention prior to docketing are identified below.

Section 609(C)(2) of the Manual of Patent Examining Procedure (MPEP) (8th Ed., Rev. 1, Feb. 2003) states:

Examiners must consider all citations submitted in conformance with the rules and this section, and their initials when placed adjacent to the considered citations on the list or in the boxes provided on a form PTO-1449 . . . provides a clear record of which citations have been considered by the Office. . . . Those citations not considered by the examiner will have a line drawn through the citation.

Page 2 of the Information Disclosure Statement (IDS) filed December 30, 1999 (no paper number given) does not comply with the above requirement. Correction is required.

In addition, further examination of the file reveals that another IDS was filed July 29, 2002 (Paper No. 22). However, it is not apparent from the record whether the examiner considered the statement submitted or notified appellants of why their submission did not meet the criteria set forth in 37 CFR § 1.97 and 1.98. A communication notifying appellants of the Primary Examiner's decision is required.

Finally, Section 1208 of the MPEP states:

On the examiner's answer, below the primary examiner's signature, the word "Conferees:" should be included, followed by the typed or printed names of the other two appeal conference participants. These two appeal conference participants must place their initials next to their name. This will make the record clear that an appeal conference has been held. [Emphasis added.]

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The Examiner's Answer mailed December 4, 2003 (Paper No. 36) does not comply with the above requirement.

Accordingly, it is

ORDERED that the application is returned to the Examiner:

1. for consideration of the references appearing on page 2 of the IDS filed December 30, 1999 (no paper number given) and appropriate notification to appellants regarding such consideration;
2. for consideration of the IDS filed July 29, 2002 (Paper No. 22) and appropriate notification to appellants regarding such consideration;
3. for taking corrective action regarding the appeals conference and for written notification to appellants regarding same; and
4. for such further action as may be appropriate.

BOARD OF PATENT APPEALS
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By: 

DALE SHAW
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